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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/761,416

01/16/2001

Mari Horiguchi

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07/14/2006

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WASHINGTON, DC 20001-4413

EXAMINER

BOCCIO, VINCENT F

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,416

Applicant(s)

HORIGUCHI, MARI

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, **WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit ~~2016~~. **2621.**

VFS

Response to Arguments

1. Applicant's arguments filed 5/2/06 have been fully considered but they are not persuasive.

(A) In re page 7, applicant states, "A prima facie .. has not been established", "To establish .. three basic criteria, 1)

- 1) a suggestion to combine,
- 2) expectation of success and
- 3) teaching all claimed limitations.

In accord to page 8, applicant states, Kim merely discloses comparison and detection means, while claim 1 recites "acquisition means for acquiring a second piece of information of the schedule of operation of the function executing means not contained in the first piece of information."

In accord to page 9, applicant further states, Kim does not disclose, "control means for putting the second piece of information in a predetermined block format and storing it in the storage means as additional information to the first piece of information."

In response the examiner agrees that the rejection must include recited limitations and further that Kim does teach

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comparison of a title with broadcast schedule data and detecting the corresponding title, the examiner agrees.

But, in accord to Fig. 7, step 470, col. 8, line 65 to col. 9, line 5, which states,

"comparison, when the data are identical ... the whole program title shown in Fig. 2B, starting and finishing time of the program, channel, date , character header", and other related text is, "stored in the memory during step 470 to thereby finish the reserved video recording establishment process during step 480."

In other words the user inputs a text TITLE, which is compared with the broadcast schedule data tiles, compares and determines if there is a corresponding title in a title field, being text, upon being compared and determined to be coincident, the other related text data is stored or the second text (cols. 8-9, starting and finishing times, channel, date, etc.....), which is not part of the first text (TITLE), but identified and detected, thereafter the second text associated with the event is stored after the first, but, based on the first text data, directly related to, "the function executing means having a schedule of operation", as claimed.

The examiner deemed that Kim is obvious to combined

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and the combination would have a reasonable expectation of success, by generating events for recording using a user input title, wherein the system can locate and set events, based on the title data, upon a coincident title, further storing the other related event data, channel, times, date etc....., based in the first text title and not part of the first text, wherein channel, times and date and other information stored in step 470, corresponds to the second text information, based in the first text information, as claimed.

Kim is deemed advantageous to any Video recording event setting system, creating events with user input titles for example, thereby locating corresponding events based on a title field, one inventive method of setting events where the user only need to provide a text input, thereafter the system can determine corresponding event text based on the title text, simplifying event setting for users, by only requiring a text input, such as a title for a desired program to be set for recording.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or

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motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Kim suggests a method of setting events by requiring only a text input from a user, thereby enhancing event setting means by, the system searches with the input text by the user, through broadcast data to locate desired events and setting into memory, only requiring a text input such as a title to do so, considered to be advantageous, novel and useful way of helping users set events.

(B) In addition Kim fails to teach a piece of information acquired and put in a predetermined block format, as required by claim 1.

In response the examiner fails to agree, a predetermined block format is met, in view of the definition or scope of the wording block.

A block can be a section of random access memory,

See MICROSOFT COMPUTER DICTIONARY.

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A block can be a quantity or number or a section of things dealt with as a unit, see WEBSTER Ninth.

Therefore, the title and other related data, channel, times, date etc..., when stored meet the limitation of blocks of data stored in memory.

While the remaining language such as predetermined block format, is also met, in view of, if the format was not known and predetermined, one would not know how to write as well as read the data, therefore, the predetermined block format is met by Kim storing the event titles first in memory to compare with corresponding titles, detect and store the other information for the event, which all storage in memory meets the limitation of a predetermined format to be successfully read later.

A format is required to be predetermined prior to the a storing operation, met by Kim, or how would one skilled in the art, read into and from the memory, without a "PREDETERMINED FORMAT", wherein the BLOCK only refers to the data being a string of data.

All arguments presented are not deemed persuasive to the examiner, therefore the rejection of maintained.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humpleman et al. (US 6,182,094) in view of Kim (US 5,526,130).

The examiner incorporates by reference the last action against the claims.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Contact Fax Information

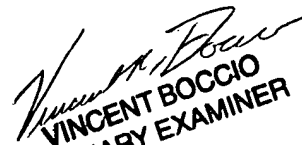
Any response to this action should be faxed to:

(571) 273-8300, for communication as intended for entry,
this Central Fax Number as of 7/15/05

Contact Information

Any inquiry concerning this communication or earlier
communications should be directed to the examiner of
record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00
PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent
7/8/06


VINCENT BOCCIO
PRIMARY EXAMINER